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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,053	10/22/2003	Chris Wimmer	MSI-1743US	6082
22801	7590	09/25/2007		
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			EXAMINER GEE, JASON KAI YIN	
			ART UNIT 2134	PAPER NUMBER
			MAIL DATE 09/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/691,053

Applicant(s)

WIMMER, CHRIS

Examiner

Jason K. Gee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 11-29 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-29, and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is response to communication: amendment filed on 08/06/2007.
2. Claims 1-4, 6-9, 11-29, and 31-35 are currently pending in this application.
Claims 1, 6, 19, and 31 are independent claims.
3. No IDS was received for this application.

Response to Arguments

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

As per the arguments regarding the motivation to add the Yoshida reference, a new reference, Chang, is used, in addition with Yoshida. Chang teaches that identifiers may be placed on hidden borders of a television broadcast. It is very well known in the art, if not obvious, that television broadcast may include multiple programs. Yoshida is used to teach that it is well known in the art that video may include multiple programs.

Claim Objections

5. Claims 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As per these claims, the applicants recite wherein an amount of the personal identity information added to the

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program is based on the security level of the program. However, these limitations are already in the independent claims.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 9 and 33 are rejected under 35 U.S.C. 101 because the claimed the disclosed invention is inoperative and therefore lacks utility.

As per claims 6-18, the claims recite retaining the personal identifier on a hidden border of a frame on the client device, and displaying the personal identifier when the video content is replayed on the same client device. However, as discussed in the applicant's specification, an identifier is hidden because it is not in the 'safe area' of a television. However, when transferred on a computing device, the computing device has a larger viewing area, and thus, the identifier can be seen. This claim however recites that personal identifier is on a hidden border on the client device, and this identifier is shown when the content is replayed on the same client device. If the first client device is a television, as described in the specification, it is not possible to display the identifier on the television, even if it is replayed. Further, claim 9 recites that the client device may indeed be a television set. According to the specification, the personal identifier is displayed when it is replayed on another device, not the same client device.

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As per claim 33, the claim recites wherein the image of the personal identifier overlays the video content when the video content is displayed. However, the independent claim recites that the image is on a hidden border, and thus, it cannot be overlaid on the video content, but on the hidden border.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 6-9, 19, 24, and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton et al. US Patent Application Publication 2003/0016842 (hereinafter Patton), in view of Chang et al. US Patent Application Publication 2003/0110516 (hereinafter Chang).

As per claim 1, Patton teaches a method comprising: receiving video content to be protected from redistribution (taught throughout the reference, such as in paragraphs 30, 32, 36 41; Figure 7); adding a personal identifier in a video content (paragraph 31), wherein the personal identifier displays information associated with a user of the video content (paragraph 31). However, at the time of the invention, Patton does not explicitly teach retaining the personal identifier on a hidden border of a frame on a television

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monitor. However, this is taught by Chang, such as in paragraph 23 and 29. As well known in the art, an image/object that is displayed outside the 'safe' area will not be displayed on a tv such as a cathode ray tube, but would be displayed in a computing device such as a computer or tv's such as hdtvs. Therefore, the personal identifier will be displayed when the video content is transferred to a computing device, because a computer device is capable of showing data outside a safe area of the tv..

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include embedding information outside the safe area of a tv. One of ordinary skill in the art would have been motivated to perform such an addition to allow embedding important information in signals that do not degrade performance and also prevents data being lost in systems. This is taught in Chang paragraph 7. Further, Chang is relevant art, as it teaches embedding information into the tv signals, such as watermarks and data used for copy protection.

As per claim 6, Patton teaches a method, comprising: receiving video content in a client device (taught throughout the reference, such as in paragraphs 30, 32, 36 41; Figure 7); adding a personal identifier to the video content, wherein the personal identifier signifies personal identity information on an owner of the client device (paragraphs 30, 31), wherein an amount of the personal identifier that is added to the video content is based on a security level of a program (paragraph 59). The other elements are rejected using the same basis of arguments used to reject claim 1 above.

As per claim 7, Patton teaches including the personal identifier in the video content when the client device outputs the video content (Figure 6A and 6B).

As per claim 8, Patton teaches wherein the client device outputs the video content by displaying the video content (Figures 6A and 6B).

As per claim 9, Patton teaches wherein the client device is one of a television, a television set-top box, a personal computer, a personal digital assistant, a digital versatile disk player, or a personal video recorder (paragraph 52).

As per independent claim 19, Patton teaches a branding engine for video content, comprising: a brand generator to produce a brand, wherein a brand includes at least one piece of personal identity information about a user of the video content (paragraphs 31, 33); a branding decision engine, wherein if the video content comprises frames, then to decide which frames of the video content are to receive a brand (paragraphs 34, 59); and an overly generator to place the brand in the video content (paragraphs 33, 38). The other limitations of the claim are rejected using the same basis of arguments used to reject claims 1 and 6 above.

As per claim 24, Patton teaches further comprising a database of personal identity information about the user communicatively coupled with the branding decision engine (paragraph 58).

Independent claim 31 is rejected using the same basis of arguments used to reject claim 1 above and is clearly taught throughout Patton. Computer readable media

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containing instructions that are executable by a computer to perform such actions are inherent to the system taught in Patton, as Patton utilizes actions that are performed on a computer.

Claim 32 is rejected using the same basis of arguments used to reject claim 8 above. This is also shown in Patton Figures 6A and 6B.

As per claim 33, Patton teaches wherein the image of the personal identifier overlays the video content when the video content is displayed (Figures 6A and 6B).

Claim 34 is rejected using the same basis of arguments used to reject claims 7, 8, and 34.

As per claim 35, Patton teaches adding the personal identifier as a video signal to the video content and outputting the video content and the personal identifier (taught throughout Patton, such as in paragraphs 30-36 and Figures 6A and 6B).

10. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton and Chang as applied above, and in view of Yoshida US Patent No. 6,411,712 (hereinafter Yoshida).

As per claim 2, Patton does not explicitly teach wherein the video content includes multiple programs. Multiple programs in a video content is well known in the art. Yoshida teaches the use of multiple programs in a video content throughout the reference, such as in Figure 23 a-e. More information may be found in col. 31 lines 30-

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43. Further, Chang deals with television broadcast, and it is very well known in the art, if not inherent, that multiple programs may exist in a television broadcast.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include multiple programs in a video content. One of ordinary skill in the art would have been motivated to perform such an addition to be able to supply multiple programs to a user so that he may have a variety of programs to view. Also, by supplying multiple programs, programs may be free or some may be paid for, as taught in Yoshida col. 1 lines 36-49.

Claim 11 is rejected using the same basis of arguments used to reject claim 2 above.

11. Claims 3, 4, 13-16, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton, Chang, and Yoshida as applied above, and further in view of Stone US Patent Application Publication 2002/0080964 (hereinafter Stone).

As per claim 3, Patton teaches throughout the reference the addition of personal identifiers, and Yoshida teaches a way to distinguish between free and subscription video programs. Also, Patton teaches that the system can determine whether or not to embed a personal identifier in paragraph 59: The Patton combination does not explicitly teach the use of metadata. However, metadata, and a distinguishment between free

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and bought metadata is by Stone throughout the reference, such as in paragraph 120-121.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include metadata. One of ordinary skill in the art would have been motivated to perform such an addition to be able to include additional information to distinguish between programs, as it would provide clarity.

As per claim 4, Stone teaches in paragraph 120 that the metadata is electronic program guide information.

As per claim 13, Yoshida teaches throughout the reference of free and subscription programs. The free programs would have low levels of security (as they are not encrypted, as taught throughout the reference), and the subscription programs would have high security levels (as they are encrypted). Metadata is taught in Stone as shown in the rejection for claim 3 above, and as seen in paragraph 120, free and bought metadata can be distinguished.

Claim 14 is rejected using the same basis of arguments used to reject claim 6 above.

As per claim 15, as best understood by the Examiner, Patton teaches wherein the displayed size of a personal identity information added to a program is based on the security level of the program (paragraph 59, wherein if the value of $n=0$, there would be no identifier, and thus, the size would be zero).

As per claim 16, as best understood by the Examiner, Patton teaches wherein the visibility of a location of the personal identity information within a displayed image of

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the program is proportional to the security level of the program (paragraph 59, wherein if the value of "n" is 0, the visibility of a location would be zero, and if n is greater than 1, the visibility of the location can be seen).

As per claim 20, Stone teaches being able to read metadata about the video content, which would inherently require a metadata reader. Security information of whether to brand the video is taught throughout Patton and Yoshida, such as in Patton 59. Yoshida teaches throughout the reference a system which can decide which program to encrypt or remain unencrypted (such as with subscription and free programs).

As per claim 21, Yoshida teaches distinguishing between secure and non-secure programs, and Patton teaches a decision whether to brand the video or not, in paragraph 59.

As per claim 22, Patton teaches wherein the security information includes a security level for a program within the video content (paragraph 59), wherein the security level determines characteristics of the brand to be added to the program (paragraph 59). Yoshida also teaches the security levels of the different programs (level of secure/encrypted and free/unencrypted).

Claim 23 is rejected using the same basis of arguments used to reject claims 14-

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12. 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton, Chang, Yoshida, and Stone as applied above, and further in view of Schmelzer US Patent Application Publication 2003/0037010 (hereinafter Schmelzer).

As per claim 17, the Patton combination teaches metadata, but does not explicitly teach wherein the metadata includes a record of the user's history of unauthorized redistribution of a video content. However, a record of the user's history of unauthorized redistribution of a video content is well known in the art, as taught throughout Shmelzer, such as in paragraph 74.

At the time of the invention, it would have been obvious to combine the teachings of Schmeizer with the Patton combination. One of ordinary skill in the art would have been motivated to take into account a user's fraudulent history to be able to ensure that the valued content is safe by determining if further protective actions need to be performed on the valued content.

As per claim 18, Schmelzer teaches taking further action when a related fraudulent history record of a user is detected in paragraph 74. The variance in display factors are rejected as shown in the rejections for claims 14-17 above.

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13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patton and Chang as applied above, and in view of Simpson et al. US Patent Application Publication 2003/0165253 (hereinafter Simpson).

As per claim 25, Patton and Simpson do not explicitly teach a store of identifiers associated with the database of personal identity information. However, a store of identifiers that are used for embedding is taught in Simpson throughout the reference, such as in paragraphs 16, 31, 32.

At the time of the invention, it would have been obvious to include a store of identifiers that are associated with a user. One of ordinary skill in the art would have been motivated to perform such an addition to be able to associate images that are to be embedded easily. Simpson is also directed toward embedding visual watermarks to protect from distribution.

14. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton, Chang, and Simpson as applied above, and further in view of Schmelzer US Patent Application Publication 2003/0037010 (hereinafter Schmelzer).

As per claim 26, Patton and Simpson teach a database of personal identity information, but does not explicitly teach a record of the user's history of unauthorized redistribution. This is taught though in Schmelzer, such as in paragraph 74.

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At the time of the invention, it would have been obvious to combine the teachings of Schmeizer with the Patton combination. One of ordinary skill in the art would have been motivated to take into account a user's fraudulent history to be able to ensure that the valued content is safe by determining if further protective actions need to be performed on the valued content.

As per claim 27, Patton teaches making a branding decision (paragraph 59). Schmelzer teaches that actions can be determined based on the record of the user's history (paragraph 74).

15. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton, Chang, Simpson, and Schmelzer as applied above, and further in view of Stone US Patent Application Publication 2002/0080964 (hereinafter Stone).

As per claim 28, Patton teaches making a branding decision (paragraph 59) based on security levels. However, the use of metadata is not taught. Metadata, such as free and bought metadata, is taught throughout Stone, such as in paragraphs 120-121.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include metadata. One of ordinary skill in the art would have been motivated to perform such an addition to be able to include additional information to distinguish between programs, as it would provide clarity and more security for the programs that need to be secured.

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Claim 29 is rejected using the same basis of arguments used to reject claim 23 above.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

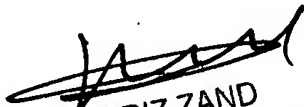
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason K. Gee whose telephone number is (571) 272-6431. The examiner can normally be reached on M-F, 7:00 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Gee
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09/17/2007


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